the text of page 28, lines 23 to 30. These newly-added claims read on the elected invention.

Claims 17, 18 and 21 have been amended to avoid having multiple-dependent claims being dependent from other multiple-dependent claims.

In view of the fact that the total number of claims has been increased by two, a remittance in the amount of $24 is submitted herewith. Kindly charge any fee deficiency to Deposit Account No. 02-2122, and advise the undersigned accordingly.

The restriction requirement is respectfully traversed. Reconsideration and withdrawal of such requirement, and action on the merits with regard to all asserted claims are respectfully solicited. Out of an excess of caution, an election is made to that which is designated I. Claims 1 to 19, 21, 22 and 24 to 27 read on this invention.

Attention is respectfully directed to the Commissioner's Notice (1046 TMOG 3) of August 1, 1984, concerning those situations wherein a product, a process for making the product and a process for using the product are concurrently claimed:

> Practice in this situation is being amended to conform to Rule 13.2(i) of the Patent Cooperation Treaty (PCT) so that a three way requirement can be required only where the process of making is not

> "especially adapted" to make the product...otherwise, the process of using must be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product...could be made.

For assistance in interpreting the cited Notice, reference is respectfully made to a memorandum opinion (copy herewith) rendered in *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks* (E.D.VA 1986).

As Applicants are entitled to claim a product, a method of making the product and a method of using the product in a single application, restriction should not be required in this application.

Claim 23 defines a combination, an essential sub-combination of which is a compound of Claim 1. Without the details of a compound of Claim 1, this claim would not be patentable. The claim thus clearly relies upon the particulars of the subcombination (as claimed) for patentability. Under the very guidelines expressly set forth on page 2 of Paper No. 6, Claim 23 is indivisible from Claim 1, from which it ultimately depends.

With regard to the sole method-of-making claim (Claim 20), the cited Notice establishes Applicants' right to a claim to making the subject products.

The rejection of Claims 1 to 19, 21, 22, 24 and 25 "under the judicially created doctrine of obviousness-type double patenting" and "under 35 U.S.C. 103 as being unpatentable over "455518 or 4560693 in view of 4255431" is respectfully traversed. The issue raised by each of these grounds of rejection is the teaching of Junggren with regard to "the interchangeability between alkyl and alkoxy". In the claims of '518 and '693 neither R2 nor R4 is alkoxy, whereas the claims of the present invention require one (and only one) of R2 and R4 to be alkoxy. Applicants respectfully submit that the analysis accorded by the PTO is an oversimplification. Moreover, issue is respectfully taken with the allegation that "Junggren et al. teaches the interchangeability between alkyl and alkoxy". An essential feature of Applicants' instantly-claimed invention is that, in addition to the alkoxy group R3, there has to be a second alkoxy group (R2 or R4) on the pyridine ring. Applicants are unable to find a second alkoxy group (in the 3- or 5-position of the pyridine ring) anywhere in Junggren's disclosure when there is, simultaneously, an alkoxy group in the 4-position of that ring. The thirty (30) compounds listed in column 9 of the Junggren patent have either a hydrogen atom or a methyl group in the 3- or 5-position of the pyridine ring. Junggren clearly does not and cannot teach the alleged "interchangeability"

between alkyl and alkoxy and would not be considered by one skilled in the art to contain such teaching.

Reference is respectfully made to the second complete paragraph on page 22 of Applicants' specification, which points out the novelty of intermediates. The noted intermediates were not available to Junggren. The preparation of such intermediates was described for the first time in this application.

The rejection of Claims 1 to 19, 21, 22, 24 and 25 "under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending application Serial No. 794,230" and the rejection of the same claims as "not patentably distinct from claims of commonly assigned 794,230" are respectfully traversed. Each of these grounds of rejection is based on the unsupportable allegation that "they contain overlapping subject matter." Such is not the case. The claims of both of these applications are independent and distinct from each other and contain no overlapping subject matter.

A Statement is submitted herewith to establish that the respective inventions are commonly owned. Please note that the stated Assignee is also the Assignee of each of USP 4,555,518 and USP 4,560,693.

Applicants respectfully note that the claims of SN 794,230 preclude any of the meanings of R1' in the designated position in combination with any of the meanings of R1 in the designated position.

Applicants further note that a similar rejection of claims "under the judicially created doctrine of obviousness-type double patenting" was made in the last Office Action in the prosecution of SN 794,230. This cross-rejection of applications on the basis of alleged double-patenting is submitted to be unwarranted. Reference in this regard is respectfully made to the opinion for *Ex parte Conner and Verplanck*, 119 USPQ 182 (PTO Bd.App. 1958), at 184:

> There is no authority known to us for the cross rejection of the claims of each of two applications as being unpatentable over the claims of the other as held herein.

The rejection of Claims 1 to 3, 22, 24 and 25 "under 35 U.S.C. 112, first and second paragraphs" is also respectfully traversed. Issue is taken with regard to the stated position concerning "optionally"; that word is readily understandable in the context in which it is used, and no one of ordinary skill in the art (to whom the claims are directed) would have any difficulty whatsoever in completely understanding the involved claims. Solely to eliminate this issue, Claims 1 to 3

have been amended in the suggested manner, which is no more definite than the originally-presented claims.

Issue is respectfully taken with regard to the position concerning Claims 22 and 23. No intended use is required for compositions which define proportions.

The position with regard to Claims 24 and 25 has been alleviated in the suggested manner.

Having overcome all outstanding grounds of rejection, an early notice of allowance is in order and is respectfully solicited.

Respectfully submitted,

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